Attorney Docket No. 0756-7279

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:	)	Confirmation No.: 9416
Shunpei YAMAZAKI et al.	)	Examiner: Muhammad T. Karimy
Serial No. 10/815,654	)	Group Art Unit: 2894
Filed: April 2, 2004	)	
For: SEMICONDUCTOR DEVICE HAVING PAIR OF FLEXIBLE SUBSTRATES	)	

RESPONSE

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The Official Action mailed December 14, 2009, has been received and its contents carefully noted. This response is filed within three months of the mailing date of the Official Action and therefore is believed to be timely without extension of time. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant notes with appreciation the consideration of the Information Disclosure Statements filed on April 2, 2004; June 30, 2004; October 13, 2004; January 10, 2005; January 27, 2005; March 3, 2005; March 15, 2005; May 17, 2005; October 25, 2005; December 8, 2005; April 26, 2006; September 18, 2006; June 12, 2007; June 14, 2007; January 11, 2008; and September 5, 2008.

Claims 48, 52, 56, 61-63 and 66-71 are pending in the present application, of which claims 48, 52 and 56 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

Paragraph 3 of the Official Action rejects claims 48 and 61 as anticipated by U.S. Patent No. 5,085,973 to Shimizu. Paragraph 4 of the Official Action rejects claims 52, 56, 62, 63, 66-68, 70 and 71 as anticipated by Shimizu, or in the alternative, as obvious

based on the combination of Shimizu and U.S. Patent No. 5,574,292 to Takahashi. Paragraph 6 of the Official Action rejects claim 69 as obvious based on the combination of Shimizu, Takahashi and U.S. Patent No. 5,427,961 to Takenouchi. The Applicant respectfully traverses the rejection because the Official Action has not established anticipation or obviousness rejections.

As stated in MPEP § 2131, to establish an anticipation rejection, each and every element as set forth in the claim must be described either expressly or inherently in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The prior art, either alone or in combination, does not teach, either explicitly or inherently, or suggest all the features of the independent claims. Independent claims 48, 52 and 56 recite a pair of flexible insulating substrates opposing to each other and a resinous layer formed over one of the pair of the flexible insulating substrates. For the reasons provided below, Shimizu, Takahashi and Takenouchi do not teach, either

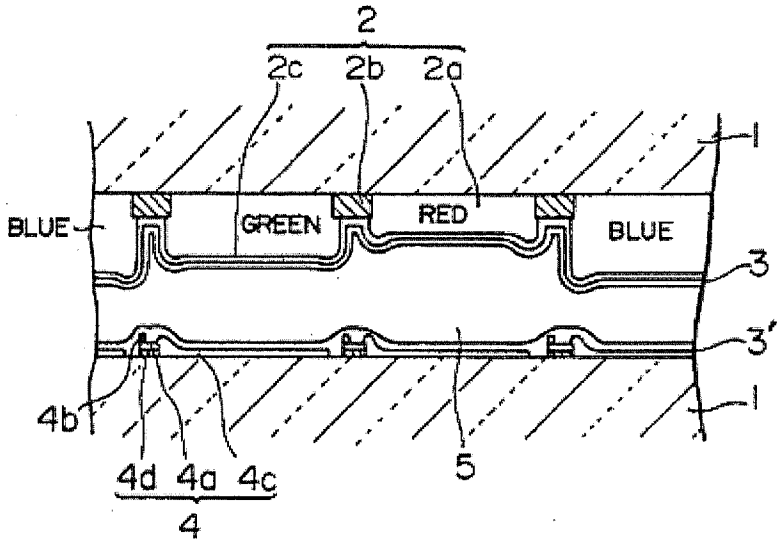
explicitly or inherently, or suggest the above-referenced features of the present invention.

The Official Action asserts that Shimizu discloses "a pair of flexible insulating substrates 1 opposing to each other (Fig. 1); [and] a resinous layer (upper surface portion of substrate 1) formed over one of the pair of the flexible substrates 1 (see Fig. 1 below)" (Paper No. 20091209, page 3). The Applicant respectfully disagrees and traverses the assertions of the Official Action.

The Official Action, inexplicably and without comment, appears to have annotated Figure 1 of Shimizu to include a line that designates part of transparent substrates 1 "resinous layer over substrate." Shimizu does not include a resinous layer over substrates 1, and does not distinguish an upper portion of transparent substrates 1 in such a manner.

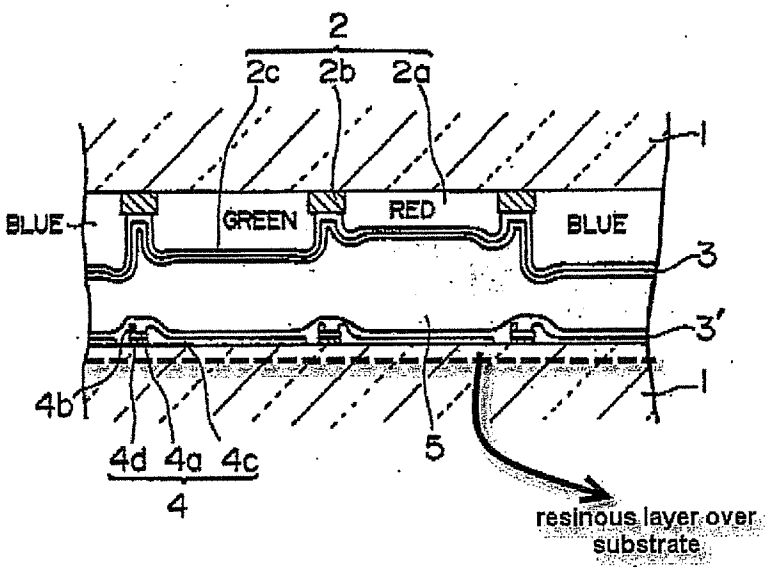
Furthermore, Figure 1 of Shimizu, reproduced below, does not include the division and reference element arbitrarily added by the Examiner. To the extent that the Examiner may have inadvertently omitted support from Shimizu or some rationale for asserting an altered version of Figure 1 of Shimizu, the Applicant respectfully requests clarification. Otherwise, the Applicant respectfully submits that the alteration of an asserted prior art figure, without further comment or disclosure, to include the claimed features of the present invention is improper and based purely on hindsight vision. In any event, the Applicant respectfully submits that Shimizu does not disclose, either explicitly or inherently, that a portion of transparent substrates 1 may be distinguished in the manner set forth in the Official Action.

FIG. 1



[Original Figure 1 of Shimizu]

FIG. 1



[Altered version of Figure 1 of Shimizu asserted by the Official Action]

Moreover, it is readily apparent that an element cannot be formed over the very same element. As noted above, the Official Action asserts that an upper surface portion of substrates 1 is formed over substrates 1. However, an upper surface portion of substrates 1 is, by definition, part of substrates 1; hence, an upper surface portion cannot be reasonably said to be formed thereover. Takahashi and Takenouchi do not cure the deficiencies in Shimizu.

Therefore, the Applicant respectfully submits that Shimizu, Takahashi and Takenouchi, either alone or in combination, do not teach, either explicitly or inherently, or suggest a pair of flexible insulating substrates opposing to each other and a resinous layer formed over one of the pair of the flexible insulating substrates. Since Shimizu, Takahashi and Takenouchi do not teach, either explicitly or inherently, or suggest the above-referenced features of the present invention, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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